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Supreme Court, U.S.
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No. _____

In The

Supreme Court of the United States

ROGER W. BROWN, Ph.D.,

Petitioner,

v.

3M and AIR PRODUCTS AND CHEMICALS, INC.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

MARIA CRIMI SPETH
Counsel of Record
GRANT, WILLIAMS & DANGERFIELD, P.C.
302 North First Avenue, 9th Floor
Phoenix, Arizona 85003-1565
(602) 258-1700 Telephone
(602) 258-6288 Facsimile
E-mail: speth@phxlaw.com
Attorneys for Petitioner Brown

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OR CALL COLLECT (402) 342-2831

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QUESTION PRESENTED

Since 1889, many courts, including this Court, have applied the following rule in patent anticipation cases:

"That which infringes if later, anticipates if earlier."

Since 1818, many courts, including this Court, have also applied the following rule or an earlier version of this rule in patent anticipation cases:

"To invalidate a patent by anticipation, a prior art reference needs to disclose each and every limitation of the claim."

Which rule should prevail when, as in this case, the application of each rule results in a different outcome?

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PETITION FOR WRIT OF CERTIORARI

Roger Brown ("Brown") respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered in this proceeding on September 18, 2001 in order to resolve the conflict between two long-standing legal tests commonly applied in patent cases to determine anticipation.

OPINIONS BELOW

The opinion of the Federal Circuit that gives rise to this petition is contained in the official reports at 265 F.3d 1349. It is reprinted in the appendix hereto (App. 1).

JURISDICTION

On September 18, 2001, the United States Court of Appeals for the Federal Circuit issued an opinion affirming the District Court of Arizona's dismissal of Brown's patent infringement claim on the grounds that Brown's patent is invalid as anticipated by prior art. Pursuant to Supreme Court Rule 13.1, this petition has been filed within 90 days after entry of the Judgment. Jurisdiction is invoked pursuant to 28 U.S.C. § 1254(1).

STATUTE INVOLVED IN THIS CASE

35 U.S.C. § 102(e) provides:

A person shall be entitled to a patent unless . . . the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent . . .

STATEMENT OF THE CASE

The District Court, which had jurisdiction pursuant to 28 U.S.C. § 1338, ruled summarily that Brown's patent was anticipated by United States Patent No. 5,600,836 (the "TOCS" patent) (App. 10).

The TOCS patent discloses a system and method for remediating databases which contain two-digit year-date codes to avoid Y2K problems. The Brown patent discloses a system and method for remediating the year-date codes in databases which contain two-, three- or four-digit year-date codes, or any combination thereof.

Claim 16 of Brown's patent provides:

An apparatus for processing year-date data in a computer system, the apparatus comprising:

a CPU;

a bus coupled to the CPU;

a memory coupled to the bus;

a system clock coupled to the bus, wherein the system clock is set to an offset time wherein the offset time is a time other than the actual time;

at least one application program stored in the memory and being executed by the CPU;

a[t] least one database file stored in the memory containing records with year-date data with years being represented by at least one of two-digit, three-digit, *or* four-digit year-date representations; and

a mechanism for converting the year-date data representations in the database file to a two-digit year-date data representation.

The District Court incorrectly interpreted the TOCS patent as disclosing a method which can remediate three- and four-digit year-date codes in addition to two-digit year-date codes. While the Federal Circuit did affirm the District Court, it did not agree with the District Court that the TOCS patent teaches a method for remediating three- and four-digit year-date codes. (App. 3, 8). In the majority opinion, the Federal Circuit assumed that the TOCS patent only addresses two-digit year-dates and also determined that the Brown patent discloses an invention which has the capability of remediating two-, three-, or four-digit year dates or any combination thereof. (App. 3, 5).

Although the Federal Circuit agreed that the Brown method has capabilities beyond those taught by the TOCS patent, the majority reasoned that the TOCS patent anticipates because had it come later, it would have infringed.

The infringement analysis applied by the majority focused on the use of the word "or" in claim 16 of the Brown patent. The Brown patent discloses an apparatus with a database containing records with year-date data with years being represented by **at least one of two-digit, three-digit, or four-digit year-date representations;** and a mechanism for converting the year-date data representations in the database file to a two-digit year-date data representation. Even though the TOCS patent only converts two digits, the majority reasoned that only converting one of the types of representations was sufficient for infringement. "By claiming his invention in the alternative, Dr. Brown has presented a claim for which infringement would lie whether or not there were also offset of three-digit or four-digit year dates." (App. 6).

The dissent, on the other hand, analyzed the anticipation question from the perspective of the well-settled rule of law that "to invalidate a patent by anticipation, a prior art reference needs to disclose each and every limitation of the claim." Using this test, the dissent determined (as did the majority) that the Brown patented apparatus has a capacity that the TOCS system does not have – the ability to remediate any combination of year-date formats. Since the TOCS patent does not disclose every limitation of the Brown claim, the dissent reasoned, the TOCS patent does not anticipate.

REASONS FOR GRANTING THE WRIT

I. Two Long-Standing Rules Conflict With One Another

The Federal Circuit decision in this matter illustrates that two long-standing and well-settled rules of law do not always produce the same result. These two rules are: (1) that which infringes if later, anticipates if earlier; and (2) to invalidate a patent by anticipation a prior art reference must disclose each and every limitation of the claim.

A. History Of The Rule "That Which Infringes If Later, Anticipates If Earlier"

In 1889, this Court first announced the rule, "that which infringes, if later, would anticipate if earlier." *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889). For well over one hundred years, this Court, as well as the lower courts, have applied this rule.

Following the *Peters* decision, the Supreme Court reiterated the rule in 1893 and 1894. *Knapp v. Morss*, 150 U.S. 221, 228 (1893). *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 203 (1894).

The Circuit Courts have applied this rule many times. *See, e.g., Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573 (Fed.Cir.1986); *Shields v. Halliburton Co.*, 667 F.2d 1232, 1235 (5th Cir. 1982); *Charles Peckat Mfg. Co. v. Jacobs*, 178 F.2d 794, 800 (7th Cir. 1949); *Toch v. Zibell Damp Resisting Paint Co.*, 233 F. 993, 994 (2d Cir. 1916); *Perfect Circle Company v. Hastings Mfg. Co.*, 88 F.2d 813, 816 (6th Cir. 1937).

The rule, "that which infringes if later, anticipates if earlier," has also been applied by the District Courts. *New L&N Sales and Mktg., Inc. v. Big M, Inc.*, 2001 WL 111613 (E.D. Pa. 2001); *Herman v. William Brooks Shoe Co.*, 2000 WL 52468 (S.D.N.Y. 2000), *aff'd*, 2001 WL 312301 (Fed. Cir. 2001); *M & R Dietetic Labs, Inc. v. Dean Milk Co.*, 203 F. Supp. 130, 142 (D.C.Ill.1961).

B. History Of The Rule "To Invalidate A Patent By Anticipation, A Prior Art Reference Must Disclose Each And Every Limitation Of The Claim."

The rule that to invalidate a patent by anticipation, a prior art reference must disclose each and every limitation of the claim has its origin in 35 U.S.C. § 102. That statute provides that a patent shall not be granted where the invention was described in a previous patent. The history of the rule reveals an evolution of its language.

In 1818 this Court stated, "a machine or an improvement may be new and the proper subject of a patent even though the parts of it were before known and in use. The combination, therefore, of old machines to produce new and useful results is a discovery for which a patent may be granted." *Evans v. Eaton*, 16 U.S. 454, 476-77 (1818). Early cases applied the rule uniformly to reject claims of anticipation made against inventions which combined elements from several different sources. *Imhaeuser v. Buerk*, 101 U.S. 647 (1879); *Webster Loom Co. v. Higgins*, 105 U.S. 580 (1881).

In later cases, when the concept of combination patents was so well-accepted that disputes over the issue no

longer existed, the rule began to take its present form. *Amphenol Corp. v. General Time Corp.*, 397 F.2d 431, 438 (7th Cir. 1968) ("In order to have anticipation, all of the elements of the patented device or their equivalents must be found in a single prior device."); *Soundscriber Corp. v. U.S.*, 360 F.2d 954, 960 (Ct. Cl. 1966). Courts routinely held that "unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference there is no anticipation." *Walker v. General Motors Corp.*, 362 F.2d 56, 58 (9th Cir. 1966). *See also Ceramic Tilers Supply, Inc. v. Tile Council of America, Inc.*, 378 F.2d 283, 284 (9th Cir. 1967); *Cool-Fin Elecs. Corp. v. Int'l Elec. Research Corp.*, 491 F.2d 660, 662 (9th Cir. 1974).

The Court of Claims has stated that "to anticipate a claim, a prior art reference must show each and every element claimed; short of this, anticipation does not exist." *Gen. Elec. Co. v. U.S.*, 572 F.2d 745, 768 (Ct. Cl. 1978); *See also Palmer v. U.S.*, 423 F.2d 316 (Ct. Cl. 1970); *Decca Ltd. v. U.S.*, 420 F.2d 1010 (Ct. Cl. 1970).

Another popular way of stating the rule is "not only is the defense of anticipation strictly a technical one, but also there is no anticipation unless all of the same elements or their equivalents are found in substantially the same situation where they do substantially the same work in the same way." *Continental Oil Co. v. Cole*, 634 F.2d 188, 209 (5th Cir. 1981); *See also Kamei-Autokomfort v. Eurasian Auto. Prods.*, 553 F.2d 603 (9th Cir. 1977); *Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc.*, 436 F.2d 1180 (7th Cir. 1971); *McCullough Tool v. Well Surveys, Inc.*, 343 F.2d 381 (10th Cir. 1965).

Today, the rule that every limitation of the claim must be disclosed in the prior art is applied in practically every anticipation case published and is well-established by Federal Circuit decisions. *See, e.g., Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed.Cir.2001); *In re Schreiber*, 128 F.3d 1473, 1477 (Fed.Cir.1997); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed.Cir.1991); *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236 (Fed.Cir.1989); *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed.Cir.1986); *Friction Div. Prods., Inc. v. E.I. DuPont de Nemours & Co., Inc.*, 693 F. Supp. 114 (D. Del. 1988), *aff'd*, 883 F.2d 1027 (Fed. Cir. 1989); *Norvell v. McGraw-Edison Co.*, 316 F. Supp 198 (E.D. Wis. 1970).

Closely related to the rule that every limitation must be disclosed by the prior art, and also having its origin in 35 U.S.C. § 102, is the uncontroverted principle that "anticipation by a prior patent cannot be sustained where the new patent constitutes a distinct patentable improvement over the old." *Dececo Co. v. George E. Gilchrist Co.*, 125 F. 293 (C.C.A. Mass 1903); *See also Fryer v. Mut. Life Ins. Co.*, 30 F. 787 (C.C.S.D.N.Y. 1887).

C. The Conflict

This case illustrates that these two long-standing rules can produce two different results. In this case, the majority acknowledged the validity of the rule that the prior art must disclose every limitation of the claim, but performed an analysis based exclusively on whether the prior art would have infringed had it come later. Indeed,

the majority never even addressed whether the prior art actually disclosed every limitation of the claim.

The dissent reached a different result by applying the rule that the prior art must disclose every limitation of the claim in order to anticipate. While the dissent also attempted an analysis based on whether the prior art would infringe, the dissent was only able to justify a determination that the prior art would not infringe by reading the claims of the Brown patent more narrowly than they were written.[1]

The conflict here arises because of the use of the word "or" in Claim 16 of the Brown patent. When a claim is stated in the alternative, it may be infringed by a device which does any of the items listed. Yet, that same "or" language describes a device which has the capacity to perform any one or a combination of functions. Both the District Court and the Federal Circuit agreed that the Brown patented device has the capacity to convert two-digit, three-digit or four-digit year-dates, or any combination. That is a capacity that the prior art simply did not have.

While the analysis of both the majority and dissent are justifiable based on the rule they apply, they produce two different results. The majority's dissent creates precedent for using the rule "that which infringes if later, anticipates if earlier," to invalidate a patent claim which discloses a significant improvement over the prior art.

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[1] It has been recognized that the court may narrow the limitations of a patent to avoid anticipation. *Dominion Magnesium Ltd. v. U.S.*, 320 F.2d 388 (Ct. Cl. 1963).

The absence of guidance from this Court on how to resolve this conflict is a compelling reason for this Court to address the issue.

II. In The Event Of A Conflict, Courts Should Analyze Whether The Prior Art Discloses Every Limitation Of The Claim.

The better reasoned approach to the anticipation question is to determine whether the prior art discloses every limitation of the claim. Courts which have applied this rule have recognized that it is based directly on 35 U.S.C. § 102. *In re King*, 801 F.2d 1324, 1326 (Fed.Cir.1986) ("it is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim"); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed.Cir.1983) ("under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference.").

The rule, "that which infringes if later, anticipates if earlier," is a catchy phrase, but it is not always accurate. A patent may infringe without disclosing every element and limitation of another patent. One example of this is where a claim is stated in the alternative, and thus, describes an invention which has the capability to address any one of three different formats or a combination of all three. There, it is enough to do only one of the listed items to infringe. Yet, where a patented invention has the capability to perform a combination of tasks, and

earlier inventions only had the capability to perform one of the tasks, the later invention is an improvement over the prior art and is not anticipated.

One of the leading treatises on patent law has recognized:

> It is frequently said: 'that which infringes, if later, would anticipate, if earlier.' But that epigrammatic formula is too broad, and those who have used it must have overlooked the distinction between primary patents and secondary patents. That which would infringe a primary patent, if later, may or may not anticipate that patent, if earlier. Where an inventor believes his invention to be primary, but thinks it may possibly turn out to be secondary, he may properly make his claim in a form that can be construed to fit his invention in either event. Afterward, when he seeks to suppress a different but competing contrivance as being an infringement of his claim when broadly construed, that contrivance may be held to infringe, if later, while not being held to anticipate, if earlier.
>
> 1 Ernest Bainbridge Lipscomb III, *Lipscomb's Walker on Patents* § 4:4 (3d ed. 1984).

Despite Lipscomb's recognition, no published decision has ever challenged the epigrammatic rule or even recognized that it may have an exception. In this case of first impression, this Court should accept certiorari and hold that the Federal Circuit has incorrectly stated the law and that when the two rules conflict, the rule that the prior art must disclose every limitation of the claim to anticipate, must prevail.

Patent protection promotes the advancement of science and technology. Patents give inventors monopoly power in exchange for full disclosure of inventions. The benefit to society of this full disclosure is that other inventors may study the invention and improve upon it. *Slimford Mfg. Co. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991) ("Designing around patents is, in fact, one of the ways in which the patent works to the advantage of the public in promoting the progress in the useful arts, its constitutional purpose"). It is important not to erode the inventor's right to patent protection of his or her distinct patentable improvements over existing technology.

Absent an announcement from this Court otherwise, the Federal Circuit and the District Courts will be bound by precedent to apply an infringement analysis to anticipation claims, and may overlook or avoid the important consideration of whether the prior art actually discloses every limitation of the claim. Continued blind application of the rule "that which anticipates if later, infringes if earlier," will result in courts invalidating patent claims which constitute a distinct patentable improvement over existing technology.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be granted.

Respectfully submitted,

MARIA CRIMI SPETH
GRANT, WILLIAMS & DANGERFIELD, P.C.
302 North First Avenue, 9th Floor
Phoenix, Arizona 85003-1565
(602) 258-1700 Telephone
(602) 258-6288 Facsimile
E-mail: speth@phxlaw.com
Attorneys for Petitioner Brown

APPENDIX

U.S. Fed Circuit Court of Appeals

00-1552

ROGER W. BROWN, Ph.D.,

Plaintiff-Appellant,

v.

3M,

Defendant-Appellee,

and

AIR PRODUCTS AND CHEMICALS, INC.,

Defendant-Appellee,

and

REVLON, INC.,

Defendant.

Maria Crimi Speth, Grant, Williams & Dangerfield, P.C., of Phoenix, Arizona, argued for plaintiff-appellant.

James J. Elacqua, Brobeck, Phleger & Harrison, LLP, of Palo Alto, California, argued for defendant-appellee, 3M. With him on the brief were *Craig Y. Allison*, and *Michelle S. Falkoff*. *Edward R. Glady, Jr.*, and *J. Marty Harper*, Goodman [sic] Raup PC, of Phoenix, Arizona, joined in the brief.

Appealed from: United States District Court for the District of Arizona

Judge Paul G. Rosenblatt

DECIDED: September 18, 2001

Before MAYER, *Chief Judge*, NEWMAN and CLEVENGER, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* NEWMAN. Dissenting opinion filed by *Chief Judge* MAYER.

NEWMAN, *Circuit Judge*.

Dr. Roger W. Brown appeals the decision of the United States District Court for the District of Arizona, granting summary judgment of invalidity of Dr. Brown's United States Patent No. 5,852,824. We affirm the district court's judgment.

DISCUSSION

The district court ruled summarily that Brown's patent was anticipated by United States Patent No. 5,600,836 (the "TOCS" patent, for Turn of the Century Systems). For the grant of summary judgment there must be no material fact in dispute, or no reasonable version of material fact upon which the nonmovant could prevail. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986) (the purpose of the summary judgment procedure is not to deprive a litigant of a trial, but to avoid an unnecessary trial when there is only one reasonably possible outcome). The grant of summary judgment of invalidity is reviewed on the same standard as applied by the district court, *viz.* whether upon application of the correct law a reasonable trier of fact could find for the nonmovant

when all reasonably disputed material facts and factual inferences are resolved in favor of the nonmovant.

Anticipation under 35 U.S.C. § 102 means lack of novelty, and is a question of fact. To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985). *See also In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962) (a compound described in a reference, and a generic claim including that compound, are unpatentable under 35 U.S.C. § 102(b)); *In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960) (a generic claim can not be allowed if the prior art describes a species within the claimed genus).

The Brown and the TOCS patents are both directed to the Year 2000 (Y2K) problem. For computer programs where the year 1999 was represented by the two digits "99," there was concern about whether in the year 2000 the programs would differentiate between the year dates 2000 and 1900, with forecasts of catastrophic consequences. One proposed solution was to reprogram the computer into thinking it was an earlier year than it actually was, so that a year date ending in "00" would

not soon be reached. The TOCS patent presented a solution of this type, wherein "two-digit years provided as inputs to the application are adjusted by either a time change value or complement value," while the output dates are represented in local time. Although it is disputed, for the purposes of review of this summary judgment we accept Brown's position that the TOCS patent does not teach remediation of other than two-digit year dates.

Not all computer databases represent the year date solely by two digits; some databases use three digits or four digits to represent year dates, especially in newer computer programs. Thus several different date formats may be running on the same computer system. The Brown invention includes adjustment of programs containing any such date systems.

The TOCS patent was licensed to a company called Unbeaten Path International Ltd. (UPI), who provided a program that, according to Dr. Brown, remediated year dates on computers running applications containing two-, three-, and four-digit year dates by setting the computer date clock to an offset time. Dr. Brown states that the defendants use this method of remediating year date data, and that by application to two-, three- or four-digit year dates, the Brown patent is infringed.

Dr. Brown's patent, filed on May 22, 1997, claims a system for setting the computer clock to an offset time, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations. Claim 16 is in suit:

16. An apparatus for processing year-date data in a computer system, the apparatus comprising:

a CPU;

a bus coupled to the CPU;

a memory coupled to the bus;

a system clock coupled to the bus, wherein the system clock is set to an offset time wherein the offset time is a time other than the actual time;

at least one application program stored in the memory and being executed by the CPU;

a[t] least one database file stored in the memory containing records with year-date data with years being **represented by at least one of two-digit, three-digit, or four-digit year-date representations; and**

a mechanism for converting the year-date data representations in the database file to a two-digit year-date data representation.

(Emphasis added.) During prosecution Dr. Brown identified the TOCS patent (filed on November 14, 1995) as the closest reference.

The district court construed the word "or" in claim 16 as meaning that the apparatus was capable of converting "only two-digit, only three-digit, only four-digit, or any combination of two-, three-, and four-digit date-data." Slip op. at 9. We agree with this construction of the claim, for it is the plain reading of the claim text. These are not technical terms of art, and do not require elaborate interpretation. There is no basis in the specification

or prosecution history for reading "or" as "and" – nor does Dr. Brown request such a reading.

Neither party disputes that the TOCS patent teaches the handling of year dates in two-digit format by setting the system clock to an offset date other than the actual date. Although Dr. Brown argues that TOCS does not anticipate the larger capability of the Brown system to conduct three- and/or four-digit date conversion, the TOCS disclosure of two-digit remediation anticipates the Brown two-digit rededication. By claiming his invention in the alternative, Dr. Brown has presented a claim for which infringement would lie whether or not there were also offset of three-digit or four-digit year dates. The principle of law is concisely embodied in the truism that: "That which infringes if later anticipates if earlier." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 USPQ 561, 574 (Fed. Cir. 1986) (citing *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889)). *See generally Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Dr. Brown argues that because the capability to act on a combination of two-, three-, and four-digit data when such data are present is not shown in the prior art, claim 16 can not be anticipated. However, claim 16 is written in the alternative, and as written would be literally infringed by a system that offsets year dates only in two-digit formats such as the TOCS system. Thus the district court correctly ruled that claim 16 was anticipated, and invalid for lack of novelty. 35 U.S.C. § 102.

Each party shall bear its costs.

AFFIRMED

MAYER, *Chief Judge*, dissenting.

I would reverse. The court errs by reading the claim term "or" exclusively, while the district court appropriately read it inclusively when construing the claim. This is not a case of a species anticipating a genus, or of a combination claimed in the alternative. Instead, the Brown patent teaches an apparatus with additional functionality not disclosed in the allegedly anticipating TOCS patent.

Claim 16 of the Brown patent includes the following limitations:

> at least one database file stored in the memory containing records with year-date data with years being represented by at least one of two-digit, three-digit, or four-digit year-date data representations; and a mechanism for converting the year-date data representations in the database file to a two-digit year-date data representation.

'824 patent, col. 18, ll. 59-65.

The "mechanism for converting the year-date data representations in the database file" refers to "the" antecedent year-date data representations in the prior limitation. Such data representations may consist of only two-digit dates, only three-digit dates, only four-digit dates, or any combination or sub-combination thereof. Therefore, although the data may vary, the mechanism always must have the capacity to convert all of the possible data sets into two-digit year-date data representations. Moreover, the "mechanism for converting . . . " limitation is stated in means-plus-function format pursuant to 35 U.S.C. § 112, ¶ 6, and must be interpreted by reference to

the structure or acts disclosed in the specification. The preferred embodiment in the specification discloses a process for converting all such possible year-date combinations to two-digit representations, before further processing to offset the system clock. *See* '824 patent, col. 12, l. 5 – col. 13, l. 7. The presence of this disclosure mandates the construction of the "mechanism for converting . . . " limitation as one that requires the capacity to process two-, three- *and* four-digit dates, even if the full capacity of the device is not always utilized.

To invalidate a patent by anticipation, a prior art reference needs to disclose each and every limitation of the claim. *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). The TOCS patent teaches a mechanism for processing two-digit year-date representations by using an offset date other than an actual date. However, it does not disclose a mechanism for converting three- or four-digit year-date representations to two-digit year-date representations for use with the offset clock. *See, e.g.*, '836 patent, col. 9, ll. 50-64, col. 10, ll. 38-67, col. 2, ll. 42-44. Although its specification states that " . . . all date data is preferably converted prior to processing by the application so that the years are confined to a single century," *id.* at col. 4, ll. 18-20, it discloses no acts or structure to perform this conversion, and makes no mention of reducing three- or four-digit dates to two-digit dates. Therefore, the TOCS patent does not anticipate because it does disclose the "mechanism for converting the year-date data representations" limitation.

Similarly, the test for literal infringement under § 112, ¶ 6 is first, whether the accused device performs an

identical function to the one recited in the claim, and, if so, whether the accused device uses the same structure, materials or acts found in the specification, or their equivalents. *Gen. Elec. Co. v. Nintendo Co., Ltd.*, 179 F.3d 1350, 1355, 50 USPQ2d 1910, 1913-14 (Fed. Cir. 1999). A system made in accordance with the TOCS patent would not literally infringe the '824 patent because it would not perform the function of converting three-digit and four-digit date representations. Therefore, because it would not infringe if later, it cannot anticipate though earlier.

Moreover, the burden of proving a patent anticipated is particularly high when the prior art was before the examiner during prosecution of the application. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1467, 15 USPQ2d 1525, 1527 (Fed. Cir. 1990). Brown cited the TOCS patent as a reference to the examiner in his application for his '824 patent. Had the examiner believed that the Brown patent was claimed in the alternative, he would be expected to have imposed a restriction requirement, or rejected the application. Instead, he allowed the claims, which use the term "or" in a practical commonsense way of claiming the single invention of an apparatus with multiple inter-related functions. This is not to say that the TOCS patent might not inherently disclose the missing limitation in the Brown patent, or that the Brown patent might not be held invalid as obvious, or even that Brown might be unpatentable as not "useful." But neither the parties nor the district court put those questions before us today.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA

Roger W. Brown, Ph.D., Plaintiff, vs. 3M; Revlon, Inc.; Proctor & Gamble; Air Products & Chemicals, Inc; Pfizer, Defendants.	No. CV 99-1577 PHX PGR **ORDER** (Filed Aug. 10, 2000)

Pending before the Court are defendant 3M's Cross Motion for Summary Judgment of Invalidity (doc. #52), defendant Revlon's Motion for Summary Judgment (doc. #78), defendant Air Product's Motion for Summary Judgment Regarding the Brown '824 patent (doc. #100), and defendant Proctor & Gamble's Motion for Summary Judgment Regarding Obviousness (doc. #104), Motion for summary Judgment Pursuant to 35 U.S.C. §112 (doc. #108), and Motion for Summary Judgment of Non-Infringement (doc. #128). Having considered the parties' memoranda and the oral argument of counsel, the Court finds that this action should be dismissed for invalidity and non-infringement since the scope of the claims are within and anticipated by the prior art.[1]

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[1] Because the Court concludes that the motions for summary judgment on issues of claim construction, validity and non-infringement should be granted, the Court need not, and does not, resolve issues of infringement jurisdiction, obviousness and testimony of experts since those issues are now moot.

BACKGROUND:

During the mid-1990s, businesses became concerned with the way computer applications would react to date-data stored in two-digits as the years got closer to the year 2000, especially if they depended on date-data and their applications were unprepared to differentiate between the years 1900 and 2000. These businesses feared these applications would crash or malfunction in trying to distinguish between the two centuries and subsequently would be detrimental to the public at large. Computer specialists started to come up with different methods on how to combat this Y2K dilemma.

On Sept. 22, 1995, a Y2K remediation conference was held, where Paul O'Neil of the Raytheon Company presented the approach his company took in handling the Y2K dilemma and how to offset date data to fool the computer's clock before it ran applications. Included in the notes are illustrations on how the program converts date-data to an offset date-data and then reconverts it back to the original date-data (hereinafter, "O'Neil presentation").

On Nov. 14, 1995, Harvey Alter filed an application for U.S. Patent No. 5,600,836, entitled "System and Method for Processing Date-dependent Information Which Spans One or Two Centuries." The patent was later assigned to Turn of the Century Solutions (hereinafter, "TOCS"). The '836 patent (hereinafter, "TOCS patent") teaches the method of processing date-dependent information where the dates were in one or two centuries and where the system did not require extensive programming changes to existing application software. It taught

the ability to encapsulate data and offset that particular date-data only, leaving data in all other programs intact. The O'Neil presentation was cited in the file wrapper of the TOCs patent as prior art. TOCS licensed use of its patented process to Unbeaten Path International, Ltd.

On May 26, 1997, Plaintiff Dr. Roger Brown (hereinafter, "Brown") filed an application for U.S. Patent No. S,852,824, entitled "Apparatus And Method For Processing Year-date Data in Computer Systems" (hereinafter, " '824 patent"). Like the TOCS patent, the '824 patent also taught the process of converting year-date data fields stored in computer databases that allowed computer systems to differentiate between centuries. However, it could handle data that spanned 199 years. The TOCS patent was cited in the file wrapper of the '824 patent as prior art.

UPI purchased the license to use the TOCS-patented process for AS/400-type computers. Some time after the filing of the '824 patent but prior to its issuance in 1998, UPI sold to the defendants its services of processing date-dependent data using the licensed TOCS process under the name Resuscitator 2000.

PROCEDURAL HISTORY

On Sept. 1, 1999, Brown filed this complaint pro se alleging that four major corporations installed or used a process that infringed on elements of claim 16 in the '824

patent[2] and even after notice, refused to stop infringing and refused to obtain a license for Brown's patented process. These corporate defendants include 3M, Revlon Inc., Procter & Gamble, and Air Products & Chemicals Inc.[3] Brown alleged that the defendants' use of a Y2K remediation system that was based on a process sold and licensed by TOCS infrnged upon his patent.

He based this infringement claim on letters posted on an Internet website. These letters were sent from members of management in the defendant corporations regarding their use of the Y2K remediation program that UPI offered. The defendants denied all material allegations of infringement in their answers to the complaint and made counterclaims, arguing that Brown's '824 patent was invalid because of prior art, including the TOCS patent.

All defendants moved individually for summary judgment based on issues of lack of jurisdiction over defendants and claim construction, non-infringement, invalidity and obviousness of the '824 patent.

Brown also moved for partial summary judgment on claim construction and invalidity.

DISCUSSION

Summary Judgment

Summary judgment is proper when there is no genuine issue of material fact and the moving party is entitled

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[2] [Reprint Of Claim 16 Omitted]

[3] Pfizer, Inc. was also a defendant, but it was later dismissed from the complaint pursuant to stipulation.

to a judgment as a matter of law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). The burden is on the movant to demonstrate the absence of all genuine issues of material fact. *Cooper v. Ford Motor Co.*, 748 F.2d 677, 679 (Fed. Cir. 1984).

Rule 56(c) of the Federal Rules of Civil Procedure provides for the granting of summary judgment motions "if the pleadings, depositions and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law."

Invalidity and Non-Infringement

There is a rebuttable presumption of patent validity. 35 U.S.C. §282. Defendants may overcome this presumption with clear and convincing evidence. *See id; See also, Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549 (Fed. Cir. 1983). When clear and convincing evidence exists, then the Court must find for the defendant. *Martin v. Barber*, 755 F. 2d 1564, 1567 (Fed. Cir. 1985).

Infringement is generally a question of fact. *Nicholl, Inc., v. Schick Dry Shaver, Inc.*, 98 F.2d 511, 513 (9th Cir. 1938); *Dawn Equipment Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1017 (Fed. Cir. 1998). However, when it appears that extrinsic evidence is not needed to explain the terms of art and a court is able to comprehend what the invention disclosed in a patent is and to determine whether one device infringes on another, the question of infringement or non-infringement is one of law. *United States v. Esnault-Pelterie*, 303 U.S. 26, 30 (1938); *Kemart Corp. v. Printing Arts Research Laboratories, Inc.*, 201 F.2d 624, 627 (9th Cir.

1953). Where there is no evidence of infringement or where evidence establishes without conflict that there is no infringement, it is the duty of the court to find for the defendant. *Martin v. Barber*, 755 F.2d at 1567; *McRoskey v. Braun Mattress Co.*, 107 F.2d 143, 147 (9th Cir. 1939).

The first step in deciding infringement of a patent is to determine the scope of the claims as indicated by the language of the claims, which is a question of law, *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 758 (Fed. Cir. 1984), after reading them and the specifications in light of the prior art. *James P. Marsch Corp. v. United States Gauge Co.*, 129 F.2d 161, 164 (7th Cir. 1942). The next step is for the trier to judge whether the claims cover the accused device, which is typically a question of fact, *Envirotech Corp.*, 730 F.2d at 758, except where it appears that no substantial dispute of fact is presented. *United States v. Esnault-Pelterie*, 303 U.S. at 30. When presented with issues of validity along with issues of infringment, the Court should decide both. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540 (Fed. Cir. 1983).

The first task for this Court is to construe independently the terms of a claim and any disputed claim terms. Claim construction is a matter of law. *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1451 (Fed. Cir. 1998) (en banc); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

The parties disagree with how the term "or" is used in claim 16 of the '824 patent. The defendants argue non-infringement and invalidity issues based on the ambiguousness of the term "or" in claim 16. They argue that Brown first alleged infringement based on the ability to

convert solely two-digit date-data and now alleges infringement on the ability to convert a combination of formatted date-data. They argue that Brown must stick to one particular format and cannot replace or interchange "or" with "and." Brown argues that since the UPI process incorporates the ability to process two-, three- and four-digit date data, processing merely two-digit date-data was sufficient to infringe on the '824 patent.

In order to construe the terms in a claim, the Court must look to the intrinsic evidence and determine whether the inventor used the terms in a claim in accordance with their ordinary meaning. *Markman v. Westview Instruments, Inc.*, 517 U.S. at 388.

The Court finds that the claim term "or" does not limit the date-data to one particular format and Brown is not replacing "or" with "and."

"Or" can be construed in various ways. "Or" is a function word that illustrates the difference between unlike things or actions. It may also be used to indicate a choice between alternative things or courses of action. "Or" can be inclusive, describing a list of alternative things in which one may choose one option or any combination of alternative options. It can also be exclusive, forcing one to choose only one option from the list of things that it conjoins.

"OR" as used in element 6 of claim 16 has always been inclusive, meaning that it was capable of converting only two-digit numbers, only three-digit numbers, only four-digit numbers, or any combination of two-, three-, and four-digit numbers.

The evidence supports this interpretation. Nothing Brown alleged has contradicted this claim construction. Brown's allegations that the current defendants and TOCS infringed even though they only converted two-digit numbers, when UPI's process had the ability to process all of these formats, is consistent with this interpretation.

Furthermore, the diagrams in the patent also support the interpretation that "or" is inclusive. The diagram labeled Figure 7 in the patent teaches the ability of the method to convert a combination of formatted data. Each year goes through a conversion mechanism which changes the year into a two-digit year-date representation, regardless if it is in a two-, three- or four-digit format.

Thus, under these circumstances, "or" in element 6 of claim 16 must be construed to include the ability to convert only two-digit, only three-digit, only four-digit, or any combination of two-, three- and four-digit date-data. This interpretation of "or" is within the ordinary meaning of the term, and is further supported by the disclosures in the patent. Based on this interpretation of "or," the Court must find that the terms in claim 16 are unambiguous.

No other terms in claim 16 are in contention. The next step is for the Court to construe the claim terms according to the prior art and determine whether the claim is valid.

A patent claim is invalid if anticipated by a prior art reference. *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991). "To anticipate a

claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Anticipation is a question of fact, including whether or not an element is inherent in the prior art, except in cases where no reasonable jury could resolve the question in favor of the patentee. *Walter-Jenkinson Company, Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39, n. 8 (1997).

The parties have stipulated that the only elements of claim 16 in contention are elements 4, 6 and 7. The other elements of claim 16 describe features in every programmable computer.

Element 4 describes the need to offset the system clock by same number of years in which the dates are offset. Based on evidence, the Court concludes this element is contained in prior art and is invalid pursuant to 35 U.S.C. §102.[4]

A prior patent may anticipate an element in a later patent if that element can be learned from the specifications and drawings, rather than from the precise language of the claims. *Minerals Separation North American Corp. V. Magma Copper Co.*, 280 U.S. 400, 402 (1930) ("The question is not what is the precise scope of the claims . . . , but what is disclosed in the specification and made known to the world."); *Lanyon v. M. H. Detrick Co.*, 85 F.2d 875, 877 (9th Cir. 1936) ("In examining a previous patent we are not limited to the precise scope of the claims of the earlier patent, but our inquiry is directed to 'what is disclosed in specification and made known to the

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[4] [Reprint Of 35 U.S.C. § 102(a) and (e) Omitted]

world.' "). However, the claims are also to be given consideration as part of the disclosure. *Application of Field*, 161 F.2d 372, 374 (C.C.P.A. 1947) ("The subject matter defined by the claims of a patent cited as a reference is part of the disclosure of that reference and may properly be considered in determining the question of anticipation.").

Brown does not dispute that the ability to offset the system clock was mentioned in the TOCS patent. He contends the defendants' use of that element was infringement because it was specifically claimed in the '824 patent and was not specifically claimed in the TOCS patent. However, the defendants cannot be found to infringe due to anticipation since the TOCS patent disclosed this element.

In its specifications, the TOCS patent teaches the need to convert the system date for the invention to be activated and that this could be accomplished by a separate procedure or by available software. Anticipation is not precluded from the fact that the TOCS patent did not specifically claim this element. Fully explaining the need to offset the system clock in order for the application to work and specifying that it was achievable through other means was sufficient to anticipate it. Based on disclosures in the prior art, element 4 of offsetting the system clock is invalid.

Elements 6 and 7 refer to a database file with combination year-date representations and a mechanism for converting those representations into an offset two-digit date-data representation. Element 6 shows the ability of the process to offset three- and four-digit date-data, in

conjunction with two-digit date-data, while element 7 teaches the need for a mechanism to convert this multi-formatted date-data.

Brown argues that the '824 patent has a unique ability to process two-, three- and four-digit date-data, a concept that that he alleges other Y2K remediation experts never considered.

Defendants argue that there is no novelty in processing a combination of multi-formatted date-data, which is supported by the fact that Brown did not claim the ability was novel over the prior art in his application for a patent. The defendants argue that at the time of the application, the novelty was in the previously unclaimed need to offset the system clock (now determined to be anticipated and invalid) and the ability to handle positive and negative integers to span 199 years. This last element was claimed in claims 1 through 15, but not in claim 16.

Based on the two patents at issue and the patent application of the '824 patent, this Court finds that element 6 and a part of element 7 are within the claims of the TOCS patent and claim 16 is invalid.

The claims of the TOCS patent support a finding of invalidity on the ability to process two-, three- and four-digit date-data.[5]

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[5] The relevant portions of the TOCS patent are claims 1 and 8. Claim 1 states:

A system for processing date-dependent information including dates in at most two centuries wherein the date-dependent

Claims 1 and 8 of the TOCS patent describe similar systems for processing date-dependent data. Claim 8 is limited to only processing dates in two-digit format, but claim 1 is not similarly limited. Claim 1 teaches the ability to process date-dependent information "comprising" a year field specified in two-digit format. That does not exclude the ability to handle year fields specified in a combination of formats, but must include year fields in two-digit format.

Although the language of claim 8 describes a similar process as claim 1, it is limited to dates in which the "year field of the dates is specified in two-digit format." Claim 1 could have shared the same language and stated that the date-data information "is" a year field specified in a two-digit format, but it did not. Instead, claim 1 uses the word "comprises," which allows the ability to process data that must include two-digit date-data, but may include other formatted date-data.[6]

The courts have held that when dealing with an invention of broad pioneering dimensions rather than an improvement patent, a liberality of construction should prevail. *Smith v. Snow*, 294 U.S. 1, 14 (1935); *Plastic Contact Lens Co. v. Butterfield*, 366 F.2d 338, 341-342 (9th Cir. 1966).

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information comprises a year field specified in a two-digit format.

Claim 8 states:

A system for processing dates in which the year field of the dates is specified in two-digit format and wherein the dates are in at most two centuries.

[6] "Comprise" is defined as "[t]o comprehend; include; contain; embrace; cover." Black's Law Dictionary (West 2000)

Patentees are generally allowed much latitude in terminology and where there are two valid constructions, the language will be accorded the meaning intended if it can be ascertained from the context.

Here, the Court finds the language of the claims in the TOCS patent construed according to their ordinary meaning support a finding of anticipation.

The specifications of the TOCS patent also support a finding of invalidity according to this claim interpretation. After first describing a system that has the ability to process "date-dependent information in which the dates are specified in a two-digit format."[7] the specifications then state two paragraphs later that "[t]he present invention also provides a method for processing date-dependent information including dates specified in a two-digit format."[8] The terms "also" and "including," along with the repetitive language that follows, means in this context that the methods apply in the same way to date-dependent information that includes two-digit format, as it does to date-dependent information in a two-digit format. "Including," as used in the specifications, means that date-dependent information must include dates specified in a two-digit format, but does not restrict it to only two-digit formats.[9]

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[7] See TOCS patent, col 2, lines 8-11.

[8] See Id. at col. 2, lines 42-44.

[9] Black's Law Dictionary defines "include" as a term that may "according to context, express an enlargement and have the meaning of and or in addition to, or merely specify a particular thing already included within general words theretofore used."

This claim construction is supported by Brown's patent application. Defendants raise the argument that Brown never mentioned the ability of the '824 patent to process a combination of two-, three-, and four-digit date-data to the patent examiner in his patent application. If this element was indeed novel and patentable over the prior art, the patentee would surely have raised it to the patent examiner in his attempts to gain a patent over the prior art. However, in Brown's Detailed Discussion of References to Support Petition to Make Special, Brown never mentioned the ability to process three- and four-digit data in conjunction with two-digit data when he was trying to distinguish his invention from the prior art.

The ability to process three- and four-digit date data in conjunction with two-digit date data is within the literal scope of the TOCS patent. This is supported by patent language, as well as evidence in the patent application showing that Brown never claimed its novelty over the prior art.

Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. *See Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985). In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art. *See id.* at 781.

An objective test to prove anticipation of an entire claim as a whole is to see if the allegedly infringing use or act infringes on both the prior art, as well as the claim at issue. If that occurs, then the prior art will anticipate the

claim of the later patent, especially if it is an improvement patent. This is based on 35 U.S.C. § 102 and the idea that patent protection on processes and their improvements are like concentric circles, with the sphere of protection on the original and first process being within the sphere of protection on any subsequent patented improvement. If, as in the case at bar, a third party makes an improvement on an existing patented process, that party's patent rights are limited to only protecting the improvement of that process and it does not also automatically gain the patent rights that come with the original process. Thus, the third party may only gain patent protection that lie outside the circle of rights on the previous patent and within the circle of rights on its own improvement patent. Otherwise, users of a process or invention would have to pay license to third parties for every subsequent improvement that they make. Clearly, Congress could not have intended the franchise on invention to be extended so far.

This Court finds that the ability to offset the system clock, to process two-, three- and four-digit date-data and covert that data, as the UPI process does, is fully disclosed by the TOCS patent. To uphold claim 16 of the '824 patent would preclude the public from practicing the TOCS patent. Thus, even if the defendants did process two-, three- and four-digit date data – which they claim they did not, they did not infringe on claim 16 by doing so because that element lies within the scope of claims of the prior art.

Based on the evidence, this Court concludes that the elements 4, 6 and 7 of claim 16 are clearly and convincingly anticipated and invalidated by the TOCS patent pursuant to 35 U.S.C. § 102.

IT IS ORDERED that 3M's Cross Motion for Summary Judgment of Invalidity (**doc. #52**), Revlon's Motion for Summary Judgment (**doc. #78**), the Motion of Air Products and Chemicals, Inc. for Summary Judgment (**doc. #100**), and P&G's Motion for Summary Judgment on Non-Infringement (**doc. #128**) are granted solely to the extent that Claim 16 of the plaintiff's Patent No. 5,852,824 is invalid pursuant to 35 U.S.C. § 102.

IT IS FURTHER ORDERED that P&G's Motion for Summary Judgment Regarding Obviousness (**doc. #104**), P&G's Motion for Summary Judgment Pursuant to 35 U.S.C. § 112 (**doc. #108**), and P&G's Motion to Strike the affidavits of Roger Brown, Albert Schmeiser and Robert Franklin (**doc. #134**) are all denied as moot.

IT IS FURTHER ORDERED that the Plaintiff's Cross Motion for Partial Summary Judgment (**doc. #117**) is denied.[10]

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[10] The Court notes that although it has determined that Claim 16 is construed as a mechanism that is capable of converting all of the year-date representations regardless of format, that conclusion does not change the Court's finding that Brown's patent is invalid pursuant to 35 U.S.C. § 102.

The Court further notes that its invalidity finding is directed solely at Claim 16 of Brown's patent and that the Court makes no finding regarding the validity of the other claims in Brown's patent.

IT IS FURTHER ORDERED that the Clerk of the Court shall enter judgment for the defendants on the ground that Claim 16 of the plaintiff's Patent No. 5,852,824 is invalid pursuant to 35 U.S.C. § 102.

Dated this 9th day of August, 2000.

/s/ Paul G. Rosenblatt
Paul G. Rosenblatt
United States District Judge